

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBORU ONISHI, KUNIHIRO HAYASHIDA
and KANJI MAMIYA

Appeal No. 94-1942
Application 07/773,603¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and WEIMAR, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 11 through 18, which are all of the claims remaining in the application.

Claim 11, which is illustrative of the subject matter on appeal, reads as follows:

¹ Application for patent filed November 20, 1991.

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11. A process for producing tubers from a tuber-forming plant belonging to the genus Solanum comprising the steps of:

(a) culturing a plant piece having at least one bud in a culture vessel containing a liquid medium comprising:

i) a carbon source and

ii) inorganic salts;

(b) exposing said plant piece of step (a) to alternating periods of light and dark while the plant piece contacts the medium;

(c) exposing said plant piece to carbon dioxide during at least one light period of step (b) to induce and propagate shoots and stolons from said plant piece;

(d) culturing said stolons of step (c) in a liquid medium containing a carbon source; and

(e) exposing at least a portion of said stolons to a gaseous phase during step (d) under conditions sufficient to induce the formation of tubers on said stolons.

The references relied on by the examiner are:

Takayama et al. (Takayama) 5,034,327 July 23, 1991

Angel M. Mingo-Castel et al. (Mingo-Castel), "Effect of Carbon Dioxide and Ethylene on Tuberization of Isolated Potato Stolons Cultured In Vitro," 53 Plant Physiology 798-801 (1974).

D. R. Paterson, "Effect of CO₂ Enriched Internal Atmosphere on Tuberization and Growth of the Potato," 100 Journal of American Society of Horticulture Science 431-34 (1975).

R. N. Arteca et al. (Arteca), "Changes in Carbon Fixation, Tuberization, and Growth Induced by CO₂ Applications to the Root Zone of Potato Plants," 205 Science 1279-80 (Sept. 1979).

Motomu Akita et al. (Akita), Mass Propagation of Potato Tubers Using Jar Fermentor Techniques," [sic] 230 Acta Horticulturae 55-61 (1988).

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The issue presented for review is whether the examiner erred in rejecting claims 11 through 18 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Takayama, Arteca, Paterson, Mingo-Castel and Akita.

OPINION

On consideration of the record, we reverse the prior art rejection of claims 11 through 18.

First, in the Answer, the examiner does not set forth a statement of the rejection under 35 U.S.C. § 103. Instead, the examiner refers to the final rejection (Paper No. 12, mailed March 1, 1993). Having carefully reviewed the final rejection, pages 2 through 8, we find that the examiner's statement does not comply with § 706.02(j) of the Manual of Patent Examining Procedure entitled "Contents of a 35 U.S.C. 103 Rejection." Consequently, we cannot determine with any certainty why the examiner believes that any individual claim on appeal is unpatentable under § 103. Suffice it to say, we agree with appellants that the examiner has not established a prima facie case of obviousness of the claimed subject matter.

Second, as best we can understand the final rejection, we believe that the examiner uses appellants' claims as a blueprint for selectively picking and choosing among various prior art disclosures to reconstruct the claimed invention. Manifestly,

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this approach involves the impermissible use of hindsight and the rejection is untenable.

The examiner's decision, rejecting claims 11 through 18 under 35 U.S.C. § 103 based on a combination of five references, is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
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)	
WILLIAM F. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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ELIZABETH C. WEIMAR)	
Administrative Patent Judge)	

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